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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,995	09/22/2003	Douglas M. Coldwell	2024728-7032762001 (03-15)	1753
7590 04/04/2006			EXAMINER	
Bingham McCuthen, LLP Suite 1800 Three Embarcadero San Francisco, CA 94111-4067			PEFFLEY, MICHAEL F	
			ART UNIT	PAPER NUMBER
			3739	
DATE MAILED: 04/04/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/668,995

Applicant(s)

COLDWELL ET AL.

Examiner

Michael Peffley

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 7-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Applicant's amendments and comments, received February 28, 2006, have been fully considered by the examiner. The following is a complete response to the February 28, 2006 communication.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 7, 8, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeVeen et al (6,575,967) in view of the teaching of Tu et al (6,231,570).

LeVeen et al disclose a device including a cannula (12) having a plurality of electrodes deployable therefrom (Figure 1). In particular, LeVeen et al teach that it is advantageous to provide a rigid cannula for providing the device to tissue (Figures 10-15). The rigid cannula has a blunt distal tip (Figures), but may include a sharpened distal tip if desired (col. 10, lines 24-26). The electrodes are solid, resilient wires (see column 4, particularly line 35) and may be deployed in a desired shape to treat tissue. In particular, LeVeen et al teach that the electrodes may be deployed in a straight line (not shown) or may be curved radially outward (col. 5, line 65 to col. 6, line 6). While LeVeen et al teach that the electrodes may be deployed in a straight line, and that wide variety of patterns are contemplated, there is no specific disclosure or depiction of an electrode array forming a flat plane.

Tu et al, as addressed in the previous Office action, disclose a similar device that comprises a catheter (1) having a plurality of electrodes disposed within the lumen of the catheter and deployable from the distal end substantially perpendicular to the longitudinal axis of the catheter (see Figure 4). The electrodes, when deployed, form a flat plane and also include a curved section (i.e. where they are deployed from the catheter). Tu et al alternatively teach that the electrodes may be deployed in a curved, everted shape just like the LeVeen et al array (see Figure 1). The tips of the electrode are blunt, and the device is provided to tissue and the electrodes are deployed to contact tissue on a flat plane.

The examiner maintains that one of ordinary skill in the art would appreciate that the LeVeen et al electrode array may be provided as a flat array to contact and treat tissue, particularly since LeVeen et al disclose the electrodes may be provided in a variety of patterns including straight electrodes, and further in view of the teaching of Tu et al who disclose a similarly deployed electrode array that may be provided as either a curved array or in a flat plane.

Claims 9-20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeVeen et al ('967) and Tu et al (570) as applied to claims 1-3, 7 and 8 above, and further in view of the teaching of Balbierz et al (6,770,070).

The combination of the LeVeen et al device with the Tu et al teaching has been previously addressed. In short, LeVeen et al teach that it is known to use a rigid cannula to provide a flexible, deployable electrode assembly to tissue, and Tu et al

Art Unit: 3739

teach that it is known to provide such an electrode array in either a curved, everted shape or in a flat plane. However, neither Tu et al nor LeVeen et al specifically disclose treating tumor tissue in a pleura. It is noted that the LeVeen et al device, which is structurally very similar to the Tu et al device, is used for the treatment of tumors, albeit not specifically in lung tissue.

The examiner maintains that the use of a device such as taught by LeVeen et al to treat any type of tumorous tissue would be an obvious consideration for one of ordinary skill in the art. In support of this assertion, attention is directed to the Balbierz et al system. Balbierz et al also disclose an electrosurgical device that includes a plurality of electrodes deployable from an elongate member for the treatment of tumors. The Balbierz et al deployable electrode device is substantially analogous to both the LeVeen et al and the Tu et al devices. In particular, Balbierz et al teach that the device may be used to treat tumors in any lung tissue (col. 8, lines 5-15). The Balbierz et al device includes a plurality of electrodes deployable from a rigid cannula (Figures 12 and 14-18) and is structurally very similar to both the Tu et al and LeVeen et al devices.

In conclusion, to have used the LeVeen et al device, as modified by the teaching of Tu et al, to treat tissue in the lung would have been an obvious consideration for one of ordinary skill in the art, particularly since Balbierz et al teach that it is known to use a structurally analogous device for the treatment of lung tumors.

Response to Argument

Applicant's arguments are deemed moot in view of the new grounds of rejection. It is noted that applicant has asserted that there is no suggestion to modify the Tu et al

Art Unit: 3739

device with the teaching of LeVeen et al to provide Tu et al with solid wires as the electrodes. The examiner agrees. However, the examiner maintains that the Tu et al reference, which teaches an electrode array may be shaped as either an everted, curved array (Figure 1) or in a flat plane (Figure 4), provides sufficient motivation to one of ordinary skill in the art to suggest that the LeVeen et al everted, curved array may also be provided in a flat plane to treat alternative tissue sites. Again, it is noted that LeVeen et al acknowledge that a wide variety of patterns are considered and that LeVeen et al also acknowledge that the electrodes may be deployed in a "straight" configuration.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

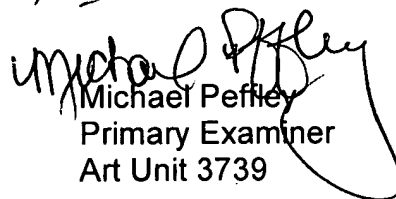
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3739

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Michael Peffley
Primary Examiner
Art Unit 3739

mp
March 31, 2006